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Supreme Court, U.S.
FILED

No. 08-__ 08-428 SEP 29 2008

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IN THE

Supreme Court of the United States

JERRY GREENBERG.

Petitioner,

v.

NATIONAL GEOGRAPHIC SOCIETY, *ET AL.*

Respondents.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Eleventh Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The questions presented here split the *en banc* Eleventh Circuit by a 7-5 margin and carry wide-reaching consequences to the future applicability of Section 201(c) of the Copyright Act. This Court, in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), explained that Congress intended, in promulgating that section, to enhance the ability of freelance artists to profit from further uses of their contributions to collective works. The questions presented are:

1. Whether, under *Tasini*, courts are limited to considering the context in which an individual contribution is presented to the user when determining if a collective work is a privileged revision under 17 U.S.C. § 201(c).

2. Whether, under *Tasini*, an aggregation of collective works, none of which has been modified, constitutes a revision of each of those works under 17 U.S.C. § 201(c).

PARTIES TO THE PROCEEDING

Petitioner is Jerry Greenberg, plaintiff-appellee below.

Respondents are National Geographic Society ("National Geographic"), National Geographic Enterprises, Inc., and Mindscape, Inc., defendants-appellants below.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Jerry Greenberg respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eleventh Circuit.

OPINIONS BELOW

The *en banc* decision of the Eleventh Circuit is reported at *Greenberg v. National Geographic Soc'y*, 533 F.3d 1244 (11th Cir. 2008) (en banc), and is reprinted in the Appendix to the Petition ("Pet. App.") at 1a-85a. The panel's decision is reported at 488 F.3d 1331 (11th Cir. 2007), and reprinted at 86a-101a. The district court's judgment entered after the jury verdict is available on PACER and reprinted at 102a-103a. The Eleventh Circuit's prior decision is reported at 244 F.3d 1267 (11th Cir. 2001), and reprinted at 104a-124a.

JURISDICTION

The court of appeals issued its *en banc* decision on June 30, 2008 (Pet. App. at 1a), and this Petition is timely filed. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The Copyright Act is contained in 17 U.S.C. § 101, *et seq.* Section 101 defines "collective work:"

> A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

Subsection (c) of 17 U.S.C. § 201, Contributions to collective works, provides:

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

STATEMENT OF THE CASE

This case implicates the careful balance of power between publishers and artists struck by Congress in the Copyright Act and affirmed by this Court in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001). It presents the question of whether a database aggregating many collective works constitutes a "revision" of each of its constituent collective works under Section 201(c) of the Copyright Act. Congress created Section 201(c) as a default rule to limit the ability of a publisher to republish contributions to collective works without providing compensation to the freelance artists who should benefit from the demand for their work after the initial publication. Section 201(c) thus creates a foundational backdrop against which publishers and freelance artists negotiate all of their contracts. Such formal and informal contracts are entered into every day, and they depend on clear default rules so that publishers

and artists alike understand when the artist is entitled to pay for the use of his contributions.

Seven years ago, this Court in *Tasini* relied on the plain language and clear purpose of Section 201(c) to find that various databases of articles from periodicals were not "revisions" of the original individual magazines and newspapers. Acting *en banc*, a 7-5 majority of the Eleventh Circuit repudiated *Tasini*'s approach, holding that Section 201(c) only requires that a contribution to a collective work be placed in "context." The court then declared that a function that lets users "flip" between adjacent pages was all that was required to satisfy that "context" inquiry. The result is that publishers can transform *any* collection (regardless of size, use, or content) into a privileged revision under Section 201(c) by merely including a "flip" feature. (Pet. App. at 14a). The Second Circuit agrees with this approach. *See Faulkner v. National Geographic Enters.*, 409 F.3d 26 (2d Cir. 2005).

The Eleventh Circuit's decision, directly contrary to *Tasini*, will only exacerbate the confusion about artists' rights that has significantly hurt their ability to receive full payment for their work, while the possibility that another circuit will follow *Tasini* will simultaneously chill many publishers from selling databases of their archives to the public. This Court should close the loophole opened by *Faulkner* and widened by the *en banc* court below, and reaffirm *Tasini's* straightforward definition of "revision."

A. Factual Background

Respondent National Geographic is a non-profit organization that publishes the National Geographic Magazine. Petitioner Jerry Greenberg is a photographer who completed various freelance assignments for the magazine. Over sixty of his photographs were published in the magazine between 1962-1990, including one on the cover.

In 1996, National Geographic used a number of wholly-owned, for-profit subsidiaries to create a database of all issues of the magazine from 1888 to 1996. Together with various other for-profit partners, it created and marketed a set of 30 CD-ROMs titled "The Complete National Geographic" ("CNG"). Each page was scanned, complete with advertisements and pictures, creating an exact image of each page as it appeared in the magazine. By clicking the "next page" button, a user can flip continuously from the first issue in 1888 through last issue of 1996.

To this, National Geographic added a 25-second video of ten famous covers (including one of Mr. Greenberg's photographs), a video advertisement for Kodak, and various software programs to allow users to search, view, and print the database of images. (Pet. App. at 32a-33a, 50a) (Birch, J., dissenting). Users can search by topic, title, key word, or contributor, and can save their search results so that any particular article can be easily accessed later. *Id.* National Geographic and its partners registered separate copyrights with the Copyright Office in the new collection as a whole and in the separate

software programs. (*Id.* at 33a, 109a). The set of 30 CD-ROMs was first published in 1997.

The CNG contains no safeguards to protect individual articles or photographs from reproduction or piracy. An inexperienced user can use standard programs, such as Windows Explorer and the cut and paste function, to copy and paste pictures from the CNG with just a few clicks. (*See id.* at 34a). Indeed, one version of the CNG purported to grant users express permission to copy images from the database for commercial use. And even the most recent version of the CNG encourages users to print copies of individual articles or images.

The CNG was an incredible commercial success. Over 1.4 million copies have been sold at up to $200 per copy, garnering tens of millions of dollars in revenue. None of that revenue was shared with the freelance contributors to the original magazines. (Pet. App. at 108a) (National Geographic refused to "provide the contributors with any additional compensation for the digital republication and use of their works"). Due to this case, and the confusion in the law surrounding publication of such databases, the CNG has been off the market since 2003. Since that time, very few magazines have ventured to brave the legal landmines surrounding the selling of their archives in new collections.

B. Procedural History

Mr. Greenberg sued National Geographic in 1997 for copyright infringement, claiming that the CNG infringes his copyrights in his individual contributions to the magazine. The district court,

having jurisdiction under 28 U.S.C. §§ 1331 and 1338(a), dismissed his claim on the ground that the CNG was a privileged "revision" of the individual print issues under Section 201(c).[1]

The Eleventh Circuit reversed (*Greenberg I*), rejecting National Geographic's claim that the database was a revision of each magazine under Section 201(c). (Pet. App. 121a). Relying on the "common sense" meaning of "revision," the court held that:

> the Society . . . has created a new product ('an original work of authorship'), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).

(*Id.* at 115a). It also held that the individual magazines, considered alone, could not be "revisions" because nothing was actually *revised*. (*Id.* at 114a, 117a n.14). The court remanded the case for trial.

At trial, Mr. Greenberg introduced evidence that National Geographic took a "damn the torpedoes" approach to copyright issues. When confronted with copyright concerns, the Editor-in-Chief of the magazine effectively shrugged: "We are so far down the road at this point that we probably just have to

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[1] Though the district court called the CNG a "revision," National Geographic insisted below that the CNG was a "straightforward reprint" and a "**republication, *not a revision.***" (Pet. App. at 36a n.8) (emphasis in original).

keep smoothing as many bumps as possible and drive like hell with our fingers crossed."[2] Mr. Greenberg also demonstrated that his photographs had independent economic value, having been licensed for use in advertising and books. In the end, the jury found that National Geographic and its partners had willfully infringed Mr. Greenberg's copyrights, and awarded statutory damages of $400,000.

National Geographic appealed, arguing that *Tasini* radically altered the legal landscape by now letting a publisher sell any database of periodicals so long as the images appear exactly as they do in the magazine, and so long as the database allows a user to directly browse between the pages. A panel of the Eleventh Circuit agreed (*Greenberg II*). (Pet. App. at 86a). The Eleventh Circuit granted Mr. Greenberg's petition for *en banc* review, but reached the same result in a 7-5 split decision (*Greenberg III*). (Pet. App. at 1a).

The *en banc* majority held that *Tasini's* test for whether a database is a privileged revision under Section 201(c) is limited to determining whether or not individual contributions are "removed from their original context." (Pet. App. at 9a). Although it acknowledged that some element of "novelty or 'newness'" was needed (Pet. App. at 11a), it found

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[2] Pl's Memo. in Opp. to Defs' Mtn for JMOL, Mtn for New Trial, and Mtn for Remittitur at 7, *Greenberg v. National Geographic Soc'y*, No. 1:97-cv-03924-AMS (Doc. 293) (S.D. Fla 2003).

that this factor is *always* satisfied where a collective work is transferred from one medium to another, such as from print to microform or to electronic media (*id.* at 12a, 18a-19a). No editorial changes or additions are necessary in the eyes of the majority.

The court also held that the "context" inquiry was satisfied, equating the CNG with microform because it presented images in their original context (albeit without any actual *revision*). (*Id.* at 11a-14a). Rejecting concerns about the obvious and practical differences between microform and the CNG, the court held that considerations such as the use, market, and effect on the contributor's copyright are "legally irrelevant." (*Id.* at 21a n.20). It distinguished *Tasini's* holding that one database of periodicals (the General Periodicals OnDisk, or "GPO") was not a revision on the basis that the CNG, unlike the GPO, allows users to "easily scroll through an entire issue" without conducting multiple searches. (*Id.* at 14a, 14a n.13). The majority conceded that this "flip" function may not matter to the user, but concluded that it dictated the legal analysis. (*See id.* ("[it] may not make a large difference from a marketing standpoint, it does from a legal perspective")).

Finally, the majority held that the addition of software programs and introductory videos was immaterial because it "in no way alters the context in which the original photographs are presented." (*Id.* at 20a). The addition of some 1,200 extra magazine issues also was not considered to be something that altered the "context" of any individual issue. (*Id.*).

While the majority only considered whether each contribution was seen in the context of its collective work, the five dissenters also asked whether the CNG was a "revision of that collective work" as prescribed by Section 201(c). Judge Birch's dissent argued that, as a perfect replica, the CNG does not *revise* any of the collective works, but that, as a comprehensive "assembly" of those works, it constitutes a new collective work. (Pet. App. at 48a-50a, 54a). He relied on the statutory language, finding that when publishers join many collective works into one collection, "*the resulting compilation is a* new anthology or new collective work, *rather than a revision of 'that collective work.'*" (Pet. App. at 41a, 41a n.16) (emphasis in original).

Judge Anderson's dissent framed the question presented by this case as whether "satisfaction of the contextual analysis always mean[s] that the new publication enjoys the § 201(c) privilege?" (*Id.* at 75a). Judge Anderson found that the majority misreads *Tasini* to find that "context" is the only thing that matters. (*Id.*). He reasoned that if a magazine issue devoted to Africa were reprinted as a chapter in a new book called "The Complete Intellectual History of Africa," everyone would agree that it was an entirely different collective work. (*Id.* at 76a). This is so even though every article is placed exactly in "context" within the original collective work. By the same token, just because an issue of National Geographic is reprinted together with other issues in the CNG does not render the CNG any more of a "revision" of that original issue than Judge Anderson's hypothetical book on Africa. (*Id.*). He also faults the majority's analogy to microform, not

only because it and CNG have almost nothing in common, but also because *Tasini* never held that microform enjoys the Section 201(c) privilege. (*Id.* at 78a).

REASONS FOR GRANTING THE PETITION

The *en banc* majority in the Eleventh Circuit, echoed by the Second Circuit, has warped this Court's holding in *Tasini* and, in the process, fundamentally reshaped the carefully calibrated balance that Congress struck in the Copyright Act. *Tasini* held that publishers and artists could agree upon compensation and paved the way for the release of archives of periodicals. *Tasini*, 533 U.S. at 505. But this has not happened because of uncertainty about whether publishers owe anything at all to artists under *Tasini*, as illustrated by the decade of litigation in this case. Few media companies are willing to publish databases of their archives without knowing whether they need to pay artists for their contributions. The Second Circuit in *Faulkner*, and now the Eleventh Circuit in *Greenberg*, in a 7-5 divided *en banc* decision, have held that a publisher can avoid paying the artist anything under *Tasini* by the simple expediency of creating "context" by including a feature that allows users to "flip" between the pages of individual magazines. Those decisions directly conflict with the analysis in *Tasini* that they purport to follow, creating confusion that only this Court can dispel.

Tasini held that whether a database is a "revision" depends on the clear purpose and plain language of the statute, which provides that a publisher of a collective work

> is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of *that* collective work, and any later collective work in the same series.

17 U.S.C. § 201(c) (emphasis added). As demonstrated by the text, Congress meant to limit the privilege to "certain limited circumstances." H. Rep. 94-1476 (1976), at 122-23, *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5737. This privilege did *not* extend to "a new anthology" or other "new collective works." *Id.*; *Tasini*, 533 U.S. at 497.

Following the statutory language, *Tasini* held that a database is not a "revision" of the original periodical issues under any reasonable definition of that term: "The massive whole of the Database is not recognizable as a new version of its every small part." *Id.* at 499-500. Applying Congress' clear intent, *Tasini* also refused to define revision so broadly as to destroy the value of the copyright in the individual contribution. *Id.* at 497-99 (rejecting publisher's definition of revision because it significantly reduced the value of the author's copyright). *Tasini* further noted that without the ability to flip between the pages of a particular issue, the databases did not even present the contributions in the context of a collective work that might qualify under Section 201(c): "either the original edition or a 'revision' of that edition." *Id.* at 500-04.

The *en banc* majority of the Eleventh Circuit fixated exclusively on *Tasini's* third factor, context, creating a legal loophole that allows publishers to transform *any* image-based database into a "revision"

by adding a "flip" function. This new approach dismisses *Tasini's* teachings about the statute's plain language and purpose as "legally irrelevant" dicta. (Pet. App. at 21a n.20). Not surprisingly, many scholars have found this test inconsistent with *Tasini's* multi-factor approach, the language of the statute itself, and Congress' express purpose. *See* Deborah Tussey, *Technology Matters: The Courts, Media Neutrality, and New Technologies*, 12 J. INTELL. PROP. L. 427, 485 (2005) (noting that this approach is inconsistent with the best reading of *Tasini* and "undercuts the policy protecting authors"); Lateef Mtima, *Tasini and its Progeny: Exclusive Right or Fair Use On the Electronic Publishing Frontier?*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 369, 425 (2004) (noting that *Tasini* considered many factors, not just "context").[3]

Nevertheless, the Eleventh Circuit majority allows any publisher to declare that any compilation of collective works is a "revision" even if it is entirely

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[3] At least one commentator agrees with the *en banc* majority that the CNG falls under Section 201(c). *See* 2 William Patry, PATRY ON COPYRIGHT, § 5:142.95 (2008). But even Mr. Patry concedes that the CNG is not a "revision" because nothing was revised. *Id.* at 5-312. Instead, he posits that each issue contained in the CNG should be seen as an individual republication of the original issue. *Id.* But the CNG cannot be "*that* collective work" under the first prong of 201(c), because, as even the *en banc* majority appears to concede (Pet. App. 17a-19a), the aggregation of many magazine issues and computer programs creates a "new collective work."

different in content, purpose, market, and user experience from the original collective works it contains. According to the majority, the "flip" function is the key factor that changes a vast collection of many disparate collective works from being "a new collective work" under *Tasini* into a "revision" of every individual collective work. This is so even though the flip function does not revise or change the content of the aggregated collective works in any way. Under this test, any database will be a revision if it shows the artist's contribution to the user in "context."

The five dissenters to the *en banc* opinion explain that the majority missed the forest for the trees. The majority looked only at each magazine, while the statutory definition of collective work (as an "assembly" or "aggregation") directs the court to consider the product itself, the CNG. This logic flows inexorably from *Tasini*:

> After all, the *Tasini* Court noted that placing all the articles from one edition of the New York Times into a CD-ROM database along with all the articles from other editions of that paper, does not constitute a revision of each edition: 'The Database no more constitutes a 'revision' of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a 'revision' of that poem."

(Pet. App. at 77a) (Anderson, J., dissenting) (citing *Tasini*, 533 U.S. at 500). The illogic of elevating the addition of a "flip" feature above all else is particularly pronounced when that feature makes

little or no difference to the user or copyright holder. (Pet. App. at 80a-81a) (Anderson, J., dissenting).

This Petition presents a clear example of a product, the CNG, that presents individual contributions in context but is not a "revision" of any particular magazine in any sense of the word, and which destroys any value in the artists' copyrights. *Tasini* spoke directly to this situation: just as "[t]he massive whole of the Database is not recognizable as a new version of its every small part," *Tasini* 533 U.S. at 499-500, it is clear that "the massive whole of the [CNG] is not recognizable as a new version of its every [monthly magazine]." This Court should reaffirm that *Tasini* requires that a court considering such a database must review all of the factors identified by *Tasini*.

A. *Tasini* Held That A Database Of Periodicals Is Not Recognizable As A "Revision" To A Magazine

Tasini held that a database of the contents of many collective works is not, by definition, a revision of each of the individual collective works. Defining a revision as a "distinct form" or "version," of the original collective work, this Court held that the "massive whole of the Database is not recognizable as a new version of its every small part." *Tasini*, 533 U.S. at 500 (citation omitted). *Tasini* explained, "[o]ne might view the articles as parts of a new compendium – namely, the entirety of works in the database. In that compendium, each edition of each periodical represents only a miniscule fraction." *Id.* A database containing a thousand issues of a magazine is not a revision of any one issue.

Although the databases in *Tasini* were not revisions, there are many clear examples of what *is* a revision. *Tasini* noted that a publisher could reprint content from the 1980 edition of an encyclopedia in the subsequent 1990 edition. *Id.* at 497. The regional or evening editions of a newspaper are, indisputably, revisions of that day's newspaper. *See id.* at 512-13 (Stevens, J., dissenting). Revisions also include yearly editions of dictionaries, adding new words and definitions, or perhaps a textbook updated periodically with current material.

These easily recognizable examples meet all of the criteria for a revision identified by *Tasini*. They are sold for the same consumer use, to the same markets, cost about the same, and do not change the nature or character of the original collective work. They may modify or update some of the content, but are regarded by everyone as a simple revision of the original. Importantly for *Tasini*, they have little effect on the subsequent value of the copyright in the individual contribution. *Tasini*, 533 U.S. at 504 (a revision cannot "effectively override[]" the artist's "exclusive right to control the individual reproduction and distribution"). Compared with the standard examples above, a database of thousands of magazines "simply cannot bear characterization as a 'revision' of any one periodical edition." *Id.* at 501 n.9.

Justice Stevens disagreed in *Tasini*, asserting that if an electronic edition of the New York Times on a computer disk could be considered a revision of the original,

> I do not see why the inclusion of other editions and other periodicals is any more significant than the placement of a single edition of the New York Times in a large public library or in a book store.

Tasini, 533 U.S. at 517 (Stevens, J., dissenting). But the majority in *Tasini* rejected this reasoning. The Court held that a database was not a revision of any one issue, it was a "new compendium" that was concerned with access to individual *articles*, not individual *newspapers or magazine issues*. *Id.* at 500, 503. The value of a database, by definition, is in the user's ability to find individual articles on desired topics.

In addition, *Tasini* held that the databases did not present the articles in the context of a collective work that might qualify for the Section 201(c) privilege. It explained that the databases "store and retrieve articles separately within a vast domain of diverse texts" and that they did not "perceptibly present[] the author's contribution *as part of a revision* of the collective work." *Id.* at 503-04 (emphasis added). The databases did not even give links to the surrounding pages or allow a user to "flip" from one page to the next. *Id.* at 491 n.2, 503-04. Completely divorced from the rest of the collective work, it was impossible for the article to be part of "either the original edition or a 'revision' of that edition." *Id.* 500, 504.

In sum, *Tasini* held that Section 201(c)'s "revision" privilege applies only to actual revisions of the *particular collective work*. It analyzed the economic effect of the databases on individual copyrights held by the artists and rejected a

definition of "revision" as "unacceptable" because "it would diminish the Authors' exclusive rights in the Articles." *Tasini*, 533 U.S. at 499. It further held that the databases were simply not recognizable as a "distinct form" of the individual periodicals in which the articles appeared. *Id.* at 500. Rather, they were *new* collective works, different in purpose and use, where individual issues were no more than "a miniscule fraction" of the whole. *Id.*[4] Lastly, it required that individual works be presented in their original context. *Id.* at 503-04. This is akin to a threshold requirement – an electronic copy of a magazine cannot be considered a "revision" if it does not bear even a superficial resemblance to the work it supposedly revises. *Id.*

B. The Eleventh Circuit *En Banc* Majority Has Repudiated *Tasini*

The Eleventh Circuit's majority ignored the two factors in *Tasini* required by the statute, the common sense definition of "revision" and the purpose of protecting the artist's rights, in favor of "context," the judicially-created third factor. It held that the only test for whether a database qualifies as a "revision"

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[4] The majority in *Greenberg III* responds to this point in a footnote, claiming that "the amount of 'newness' will certainly impact the contextual inquiry." (Pet. App. at 19a n.18). Yet if 1,200 magazine issues crowded with one magazine issue ("that collective work") does not impact the context of that one issue, it is difficult to imagine what the majority imagines could change the context.

under Section 201(c) is whether individual contributions are presented to the user in their original context with some modicum of "newness." This is so even if the database is entirely different in content, purpose, market, and user experience from the original collective work. The Eleventh Circuit has effectively adopted Justice Stevens' dissent, holding that so long as each issue is a faithful reproduction of the original, the "inclusion of other editions" to create a new collective work is not "any more significant" than the inclusion of the issue in "a large public library." *Tasini*, 533 U.S. at 517 (Stevens, J., dissenting).

Tasini held that a freelancer *must* be able to benefit from the inclusion of his work in "a new collection" or "new collective work," such as the LEXIS/NEXIS or GPO databases. *Id.* at 497. The Copyright Act defines "collective work" as a work "in which a number of contributions constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. If those databases are "collective works" under the statutory language, not a revision of their constituent periodical issues, then so is the CNG.

The contrast between *Tasini*'s approach and of the majority below is most apparent when comparing the GPO at issue in *Tasini* with the CNG in this case. Both are image-based collections that allow users to search the universe of their contents, display articles as separate items within the search results, and display the requested pages complete with photographs, captions, and advertisements. The only real difference, as recognized by the *en banc* majority, is that the CNG allows a user to "flip" from article to

article in the scanned pages. (Pet. App. at 14a). The majority held that this single difference was enough to dictate a different outcome under *Tasini*, making the CNG a revision of each individual magazine. (*Id.* at 14a, 14a n.13 ("While the 'flip' function of the GPO may not make a large difference from a marketing standpoint, it does from a legal perspective.")). By turning this feature into a proxy for "context" that can constitute a revision, the court ignored *Tasini*'s teachings about why the GPO is not a revision of an individual magazine under Section 201(c), and therefore radically reshaped the governing legal standard.

The *Tasini* Court offered three principal reasons why the GPO is not a revision.

1. The first is premised on the express purpose of Section 201(c): "If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand." *Tasini*, 533 U.S. at 497. Reselling individual periodicals as a part of massive databases eliminates the value of individual contributions, so an interpretation of the statute that destroys that value cannot be correct. As the Court noted, few people will buy a collection of stories or photographs if the individual works are "freely and permanently available on line." *Id.* at 497 n.6. And who would buy the rights to a photograph if it, bundled with tens of thousands of other individual works, was available for the same price?

In response, the publishers in *Tasini* argued that they were merely exercising their privilege to reproduce a revision of each individual collective

work, and that each database was only a forum for many individual revisions of collective works, not a collective work itself. *Id.* at 499. The Court squarely rejected this "encompassing construction" of the meaning of revision as "unacceptable" because it would "diminish the Authors' exclusive rights" – the opposite of what Section 201(c) was intended to do. *Id.* The right to republish the articles in a "new collection," which the databases undoubtedly were, inures to the author. *Id.* at 497. After all, the express intent of the 1976 legislation that created Section 201(c) was "to enhance the author's position vis-a-vis the patron." *Id.* at 496 n.3.

This point was echoed by Judge Anderson in dissent, who explained that National Geographic was selling

> an entirely new product – a sophisticated research tool capable of readily accessing and isolating any article or subject matter . . . thus appealing to a new market. I do not believe that § 201(c) can encompass the magnitude of the changes wrought here.

(Pet. App. at 80a) (Anderson, J., dissenting). Aggregating 1,200 issues of a magazine together creates a "new product in a new format with these new features and these new uses." *Id.* This is a new collection that creates a right to compensation for contributors. (*Id.* 80a-81a). The *en banc* majority, of course, dismissed this market analysis as "legally irrelevant." (*Id.* at 21a n.20).

2. Next, *Tasini* turns to the plain meaning of the word "revision" as used in the statute. *Id.* at 500. The compilation of articles from thousands of

collective works does not constitute a revision of those collective works: the "massive whole of the Database is not recognizable as a new version of its every small part." *Id.* The Court saw this new product for what it is, what consumers expect from it, and how it is marketed: "a new compendium – namely, the entirety of works in the Database." *Id.* An individual magazine within the whole of the database (of 1,200 magazines in the CNG) "no more constitutes a 'revision' of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a 'revision' of that poem." *Id.*; *see* Tussey, 12 J. INTELL. PROP. L. at 484-85 (the best reading of *Tasini* is that "an accumulation of issues . . . is a new anthology collecting multiple, previous compilations").

Though the Court held that databases must be considered as one collective work and not as multiple individual revisions of magazines, *Tasini*, 533 U.S. at 499, it did recognize, alternatively, that they might be viewed by the user as "individual articles presented individually." *Id.* at 500. But this characterization does not help either the GPO or CNG become "individual *collective works* presented individually." The purpose of those databases is to let a user search for individual contributions, not particular magazine issues. There is no consumer demand for individual archived magazines, and which article goes with which magazine is irrelevant to the user. If National Geographic had switched various articles between various issues in the CNG, few users would notice or care.

The dissenters below echoed *Tasini*'s holding, noting that Section 201(c) allows for revisions of only "that particular collective work," not massive

databases. (Pet. App. at 41a-42a) (Birch, J., dissenting). Neither Congress nor this Court allows a "new anthology" or "other collective work" to masquerade as a "revision." (*Id.* at 42a). The CNG is nothing if not a new anthology and new collective work. (*Id.*); 17 U.S.C. § 101 (definition of "collective work"). In response to Justice Stevens' question of why publishers cannot publish all the issues together if they can publish each issue individually, *Tasini* and the dissenters answer together: "*the resulting compilation is* a new anthology or new collective work, *rather than a revision of 'that collective work.*" (Pet. App. at 41a n.16) (emphasis in original); *see Tasini*, 533 U.S. at 500.

These twin holdings are dictated by Congress' clear purpose in enacting Section 201(c), and its understanding of the limited nature of the publisher's privilege. Mtima, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. at 375 (noting that these two holdings are the "two principal bases upon which" *Tasini* "disqualified the digital re-publications from shelter within the special statutory privilege"). Congress explained that "the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine of other collective work." H. Rep. 94-1476, at 122-23, *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5737. Indeed, soon after it was enacted, an attorney for a major publisher conceded that the privilege was very limited: "the right to include the contribution in any revision would appear to be of little value to the publisher." (Pet. App. at 27a n.1) (Birch, J., dissenting) (citation omitted).

3. *Tasini*'s third reason for denying the status of revision to the GPO was that it did not place the articles in context because it did not allow users to move directly between articles in the same issue. Of course, the CNG's flip feature meets this one contextual criterion. And on that basis alone the *en banc* majority dismissed *Tasini*'s two other holdings as irrelevant. Yet Judge Anderson, in dissent, explained that this was the *weakest* of the three reasons:

> As a matter of common sense and common experience, that is not a difference that would make a difference to the user, or to the publisher whose interest is marketing the new product. The existence *vel non* of the flip feature is similarly irrelevant to the authors of the individual articles.

(Pet. App. at 81a) (Anderson, J., dissenting). Judge Birch, also in dissent, noted that one could make a "digital microfilm" that would allow a user to go from page to page. (*Id.* at 53a) (Birch, J., dissenting). But without the comprehensive database and search feature, such a product "would not be marketable." (*Id.*). The "flip" feature defines print and microform – it is largely irrelevant to electronic media and is hardly a sufficient basis to depart from *Tasini*.

The *en banc* majority actually conceded that the context of an individual article "may not make a large difference from a marketing standpoint." (*Id.* at 14a n.13). But they held that *Tasini* required them to turn a blind eye to such realities, and treat the question from a purely "legal perspective." (*Id.*). Yet, as *Tasini* explained, whether a product is considered

a "revision" of a collective work should depend upon its effect on an artist's individual copyright, the intended market, and its avowed purpose and use.

The Eleventh Circuit has thus rewritten *Tasini*, so that "context," defined by the ability to flip between pages, is all that matters for the legal test for a revision, even though it makes no difference to the user, the publisher, or the author. The conflict with *Tasini* could not be more stark.

C. If The Circuits Have Not Misread *Tasini*, Then *Tasini* Has Proven To Be Unworkable

The legal test introduced by *Faulkner* and enhanced by *Greenberg III* has implications far beyond this Petition. The Second and Eleventh Circuits' misreading of *Tasini* creates an easy workaround for publishers desiring to benefit from the demand for individual works without paying the artist. This is inimical both to *Tasini* and congressional intent, and at a minimum illustrates the need for the Court to clarify *Tasini*.

The *en banc* court's interpretation of *Tasini* makes a mockery of Section 201(c). Though it holds that context is "the bedrock of any § 201(c) analysis," closer scrutiny reveals that this bedrock is nothing more than the ability to move between pages. (Pet. App. at 24a). And the only other requirement is "newness," which is apparently satisfied by the move from print to electronic media. (*Id.* at 11a-12a, 18a-19a). No actual *revisions* are necessary in the Eleventh Circuit's view. Nor must the new products

resemble in any meaningful way anything that was contemplated by Congress.

Defining revision in terms of "context" is unworkable as a general test, even for products similar to the CNG. For example, if an online magazine wished to sell its archives in print or DVD, how would it provide context? Would it have to include the banner advertising, hyperlinked content, reader commentary, videos and podcasts, web-style formatting, and its search engine? It is impracticable, and likely impossible, to reproduce the "context" of a website in any other medium. Nor does the focus on recreating a reader's experience – the importance of allowing a reader to "flip" between content the same way as in the previous media – make any sense. One clicks from page to page in a website; this is simply not possible in print. *Tasini's* approach is far more workable than the draconian test adopted below.

And the "context" loophole recognized by the Eleventh Circuit utterly destroys the ability of artists to benefit from their works. So long as publishers use an image-based database with a flip function, they can place their entire archive of magazines or newspapers on the web for free, benefiting from advertising revenues or increased traffic. Yet the artist receives nary a penny. The majority's reasoning below knows no constraints, as it in no way is limited to CD-ROMs or other disks, but applies just as readily to the Internet and to magazine archives posted online. Publishers can sell access to individual articles, stories, or pictures, so long as the rest of the pages in the issue are a click away. Once a Google search can find it, the author's copyright for

that individual text, picture, or video is essentially worthless.[5] Under the majority's decision, nothing prevents National Geographic from putting the CNG's search engine online, linking directly to the desired article exactly as it does on the CD-ROMs.

Supporters of the context-only test for Section 201(c) celebrate the approach in *Greenberg II* as a complete victory for publishers:

> Similarly, so long as the original context is preserved, how access is controlled to the original or parts thereof, is irrelevant. Current models in the newspaper and magazine field run the gamut from free, unfettered access, password protected but free access, and paid subscriptions. Pay-per-view may even be broken down by individual articles or issues. None of this matters, so long as the original context has been preserved.

Patry, PATRY ON COPYRIGHT, § 5:143 at 5-315. This new paradigm "would scarcely 'preserve the author's copyright.'" *Tasini*, 533 U.S. at 497.

The majority's decision below thus eliminates a freelance artist's motivation to create works that will maintain relevancy or value in the future. Thomas Dallal, *Faulkner v. National Geographic Enterprises,*

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[5] For example, a spokesman for the new archive of Sports Illustrated Magazine (*see* http://vault.sportsillustrated.cnn.com) hopes that when "someone searches Johnny Unitas" then "SI.com is going to pop up." Richard Pérez-Peña, *Dusting Off the Archive for the Web*, NEW YORK TIMES (Mar. 17, 2008).

Inc.: Driving a Truck Through the Eye of a Needle, 15 TEX. INTELL. PROP. L.J. 63, 88 (2006) (former photojournalist explains that *Faulkner* will "chill the creation of new works by freelance authors because they can no longer rely on being able to reap the residual income that their works have historically generated."). As mentioned above, Congress sought to balance the bargaining power between publishers and freelancers, rejecting the idea that artists should cede all exclusive rights to a publisher. No publisher offers consideration for rights it can simply claim, and as we have seen, the "revision" right created by the Eleventh Circuit majority is almost boundless.

In addition, when publishers release these database archives on the web or on disk, they have no incentive to protect the individual artists' work. Publishers could allow users to drag-and-drop images from their magazine off of the web, and would never be responsible for inducing infringement. *Faulkner*, 409 F.3d at 40 ("there can be no contributory infringement absent actual infringement"). Indeed, the CNG contains no copy protection at all. In his dissent, Judge Birch explained how a user (using only standard programs) can copy, edit, and transmit any picture from the CNG with just a few mouse clicks. (Pet. App. at 33a-34a) (Birch, J., dissenting). The artist has no means of protection under the Eleventh Circuit majority's regime.

The majority dismissed the dissenters' concerns about the destruction of the author's copyright by holding that "this is not the proper inquiry under *Tasini*." (Pet. App. at 11a n.10). They likened the CNG to microform: "this is no different from material in microform where a user can print only a portion of

what is contained on a microform roll or a microfiche sheet." (*Id.*). But, microform has almost nothing in common with commercial databases. Most importantly, microform is non-commercial by nature. Nat'l Geo. En Banc Pet. (from *Greenberg I*) at 14 n.4 ("Not surprisingly, very few (if any) individuals buy microfilm or microfiche . . . for home use."). Microform is not sold to consumers and cannot be easily put on the web. Nor can microform be readily copied for use in other media—one cannot cut and paste from microfilm into a computer. It also contains no additional copyrightable elements, such as a search function or the CNG's introductory montage.

The vigorous disagreement between the majority and dissent about whether the value of the artist's copyright matters at all confirms that this Court's attention is needed to both uphold *Tasini* and eliminate the confusion that it has engendered.

D. This Case Represents an Ideal Vehicle To Explore Important Legal Issues Concerning The Copyright Act

This case presents the perfect vehicle for resolving the correct test for a "revision" under Section 201(c). There are no disputed factual issues, the parties have the benefit of a jury verdict on infringement and damages, and the parties, courts, and scholars have been debating this case and its implications for over a decade.

Even National Geographic has repeatedly recognized the importance of resolving the fundamental uncertainty:

> And even more fundamentally, clarification of the law in this area is vital to the preservation and diffusion of collective works in an era of rapid technological change . . . At issue here, in short, is the future of public access to digital information depositories.

Resp. to Pet. for Writ of Cert., *Faulkner v. National Geographic Enters.*, 126 S. Ct. 833 (2005) (Nos. 05-490, 05-504, 05-506), 2005 WL 2985713 at *10-11.

Until *Tasini*'s meaning is resolved, one way or the other, archives of artists' contributions will be stuck in an uncomfortable limbo. Only a handful of publishers have been brave enough to sell copies of their archives to consumers.[6] And some of those that have been published are not focused on usefulness, but rather on fitting within *Faulkner* and *Greenberg III*. For example, the recently-published *New Yorker* archive was designed "largely based on [*Tasini*'s] remarks about preserving context" – and the result was a "low-tech" product that frustrates many users. Jessica Mintz, *New Yorker on DVD is Readers' Delight, Surfers' Frustration*, WALL STREET JOURNAL (Nov. 10, 2005); Alex Beam, *It's a Case of Who Owns*

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[6] Once a publisher grants access to its archives, it exposes itself to liability from its freelance artists if any court later disagrees with *Faulkner* and *Greenberg III* and finds that the release violated the artists' rights. As a practical matter, only a relative trickle of archives will be released until this Court clarifies the matter.

the Words, BOSTON GLOBE (Oct. 4, 2005). Needless to say, the *New Yorker* archive was published without any compensation to freelance authors or artists. *Id.*

The future of easily-accessible digital archives is online, or perhaps in media that we cannot predict at this juncture. Regardless, the outcome of this dispute will determine whether freelance artists will share in the benefits of modern technology. Once a periodical archive is posted online, the value of a freelance contributor's copyright becomes *zero*. This Court should clarify that publishers cannot reap the benefits of appropriating the market for the freelancer's individual works without compensating the freelancer. Finally, without a clear test under Section 201(c), the future of projects such as Google or Yahoo's efforts to digitize books, and features used by many online retailers to publish excerpts on the web, remain uncertain. *See, e.g.*, Jonathan Kerry-Tyerman, *No Analog Analogue: Searchable Digital Archives and Amazon's Unprecedented Search Inside the Book Program as Fair Use*, 2006 STAN. TECH. L. REV. 1, ¶¶35-41 (2006) (noting the problematic application of *Tasini* to Amazon's "Search Inside").

But as important as it is for major publishers and successful artists, the impact of *Greenberg III's* interpretation of *Tasini* will chiefly fall upon the masses of freelance contributors. Tens of thousands of community papers and magazines, websites and blogs, software and video ventures (among others), create collective works from freelance contributions, paid or not. Most of these parties will not contract around the default privilege created by Section 201(c). And as a result, the *en banc* majority will allow these publishers to expropriate the individual

contributions in almost any manner without payment, no matter what the purpose, use, or effect the new use has on the freelancer's copyright. The Eleventh and Second Circuits have turned *Tasini* into a cipher, expanding the privilege to cover almost everything on disk or the internet. This Court should correct that error and reaffirm its holding in *Tasini*.

CONCLUSION

For all of the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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September 29, 2008